

REMARKS

The Applicant wishes to thank the Examiner for his help and courtesy during the interviews on March 4 and 21, 2008. The Applicant appreciates the Examiner extensive experience in the field of commercial print or advertising. The Applicant appreciates the time that the Examiner has taken to better understand the field of the claimed invention which the Applicant believes is less related to commercial print and commercial advertising than may have been previously understood.

The Applicant also wishes to thank the Examiner for the Examiner's patience in allowing the Applicant to explain how the claimed invention contrasts with the commercial print or advertising industry. During the interview, the Applicant has endeavored to clarify the terminology in the claims, and the legal distinctions that can be drawn between the many commercial application of for-profit publications and Applicant's claims that are directed to not-for-profit, charity or fundraising. As explained, the Applicant has found no direct or indirect comparison in the not-for-profit arena.

As discussed in detail during the interview on March 4, 2008, "ad-books" and related publications are used by non-for-profit organizations for the specialized purpose of obtaining donations from members and supporters. Ad-books provide an excuse to solicit and give, despite the nominal value of the published recognition and to make laudatory statements such as in support or to express affinity to the group, its cause, an honored member or event. Not-for-profit organizations may cover a wide diversity of organizations including religious (e.g., churches, synagogues, etc.), schools (private, public, teams), clubs (e.g., boy scouts, girl scouts, sports leagues, etc.), political, fraternal organizations (e.g., Elks, Shriners, Masons, etc.) humanitarian (e.g., local children's hospitals, food-banks, homeless shelters, etc.), arts (e.g., community theatre, symphony, museums, etc.), just to name a few fields and examples. These "ad-book" publishers are decidedly not in the for-profit business and not in the business of publishing. Nor do they offer these services to the public for the services of publishing.

As also discussed, "ads" placed in an "ad-book" are not placed for the typical

commercial advantage or expectation. Instead “ads” are placed in “ad-books” primarily to make a gift to the organization and secondarily to provide recognition to the giver. As such, “ad-books” are not the same as and are not used for the same purpose as commercial advertising. Also, in contrast to commercial advertising, “ads” in “ad-books” are often not placed with any expectation of quantity, in terms of circulation. Commercial publications are typically directed to content, ads and circulation to the general public, and operate their business and pricing accordingly. Thus, the more the circulation to the general public (or target audience) the more value the advertisement has to the publisher and the advertisement rates are often set accordingly. By contrast, the claimed “ad-book” and related publications typically have minuscule circulation that is parochial in nature, are often only privately circulated within the group and are not sold to the general public or with public appeal base on content in mind. Often the finished “ad-book” is only circulated within the group or at a group event.

The context and purpose for using not-for-profit “ad-books” clearly differentiates the use of the charity/fundraising “ad-books” from commercial advertising, in general, and commercial ad-books in particular. As discussed in the March interviews, one may be familiar with all forms of commercial print or published advertising (such as magazines, newspapers, mailers, etc.) and never have encountered the more parochial not-for-profit “ad-books” for charity or fundraising. “Ad-Books” are either directed to an internal audience or not widely circulated. Not only are there social, communal or economic reasons why some people may never come across or be solicited for an ad-book, but heretofore, lacking the technology envisioned by the invention, fewer groups could or would exploit the “ad-book” as a fundraiser due to its difficulties or such factors as frequently changing leadership or turnover in groups. The example given in the March 2008 interview was an 8th grade fundraiser for the Inventor’s child to fund the class-trip to Washington DC. Through annual events, such as this, at many schools, it should be obvious that each 8th grade class moves on to graduate leaving the next year’s 8th grade class as novices that must practically start from scratch on their “ad-book”. Such non-commercial / volunteer or community-based groups lack the focus, continuity and capital to attract the attention of for-profit companies.

As discussed during the interview on March 4 and March 21, 2008, “ads” within

the field of the claimed invention are also messages of support or affinity and are often placed in “ad-books” for purposes of lauding the organization, its activities or its members. Examples of laudatory statements found in “ads” or messages in charity/fundraising “ad-book” may include, “In honor of ____ from.....”, “Congratulations...”, “Good Luck...”, “Proud sponsor of...”, “We Support You...”, “...committed to helping those who help ...”, “...With Love...” and many more. The context of such publications has previously been described as being used in conjunction with not-for-profit, charity or fundraising events such as a group golf-outing, school play, annual banquet, or membership directory. The language and use suggest differences from commercial or for-profit publications that would be clear to those familiar to both fields and the two types of publications would rarely if ever interact.

In the field of the claimed invention the “ads”, or messages, are often placed by individuals or families, personally, not through a corporation, as is typical of an ad by a for-profit company in a commercial publication. By contrast, it is hard to imagine a person or family paying for an ad, at commercial rates to a for-profit company to express a laudatory statement in a commercial publication. A closer examination of the companies who do place ads or messages in not-for-profit organization’s “ad-books” would often reveal that each such company had a personal involvement or affinity with the group (such as the example given by the Inventor who, as a home builder, may advertise in his kid’s school ad-book, not because he expects his kids parents to buy a house from him, since the Applicant builds for a different market, but as explained, just as one more reason for the Applicant to give (and be seen giving) within his own community).

As also discussed, the process of creating “ad-books” has, in the past, been a poorly automated process carried on by members of the organization or by free-lance temporary help for the occasional annual project. Tools used in the past have primarily been limited to a typewriter/word processor, tape-up or limited-non-networked graphic programs and a copying machine or short-run local print/copy store. Volunteers would collect information from contributors on paper forms, collate the materials into individual pages and print the “ad-books” as community or committee project. Groups often lack the service or technology to “out-source” to a 3rd party, as envisioned by the claimed

Invention, let alone to do so with the economies of scale which the claimed Invention hopes to achieve to add more unify the process.

Moreover, the claimed method and apparatus for creating “ad-books” is not simply the automation of an old process. For example, in the past, “ad-books” were typically limited to the graphical materials that were already available to the not-for-profit organization. Incorporation of non-standard materials was simply not possible because of the limited nature of the information processing of such not-for-profit organizations. Also, since organizations for similar causes are typically very localized, and not part of a larger national corporation, or “franchise” they can not compare and share resources, information processing or best-methods. The claimed Invention is intended to better enable like-kind not-for-profit, charity and fundraising groups to interact as part of larger social networks for the purposes of better facilitating their separate ad-books. In addition to these potential qualitative interactions, a 3rd party “ad-book” organization, as envisioned by the claimed Invention, could add the function of accepting and processing credit-card payment on-line, and the associated accounting and payment notification. By allowing the 3rd party “ad-book” organization to process credit-cards, not only does that processing save the laborious manual process of writing and processing paper-checks; but, since many (if not most) not-for-profit, charity or fundraisers are not outfitted to accept credit card payments (let alone on-line payments), it enables greater out-reach using e-mail forms to givers, acceptance of payment on-line and, in addition, gathers donors information for data-base use in the future.

The legal distinctions between the charity or fundraising “ad-book” field and the field of commercial / for-profit publishing or advertising were also further explained in the March 4th 2008 telephone conference, such that, despite the similarities in colloquial language which may describe the industries similarly, there is a large body of information which more accurately describes and differentiates the two. A commercial, for-profit ad-book publisher is a company, registered in its state as a for-profit company and that files its for-profit company state and federal tax-returns. In contrast, a legally defined not-for-profit entity may or may not be required to register with the state (as some types are exempt) and, if they are of sufficient size to require filing of state and local taxes, they are clearly defined by the laws as one of several types of not-for-profit organizations.

Thus, there can be little confusion between the two, and to the extent there is any such confusion, they would be differentiated by the statutes and case-law in each instance. Likewise, while an advertiser within a for-profit or commercial publication would be issued a receipt for commercial advertising, and may apply that amount to their regular cost of doing business when calculating their taxes, an individual making a contribution and simple laudable statement to the public in an “ad-book” of the not-for-profit publication would not. In this regard, an individual placing an “ad” or message with their charity, not-for-profit or fundraiser would be considered a donor and be afforded no or nill consideration for costs of doing business, but would receive an acknowledgment of donation that can be applied as a charitable donation against business or personal taxes. Furthermore, the person placing commercial or for-profit ads is bound by a “contract” where a promise to not-for-profit or charity is considered a “pledge” and, though equally binding, a “contract” and a “pledge” are governed by different laws, which also support both the difference in the field of the invention as well as to clarify any distinction at law or in equity.

Nor are the claimed method an obvious variant of old methods. For example, the claimed method incorporates method steps and apparatus that were not known in the context of “ad-book” publications. The use of an advertising preparation tool within an ad-book server, for example, provides a set of tools and steps for preparing an ad-book that would not have been know in the prior art.

The Claims

Independent claim 1 has been further limited to the context “wherein at least some of the “ads” or messages in the “ad-book” or related print publication contain laudatory statements about the legally defined not-for-profit organization, its activities or its members.” Independent claims 28, 29 and 50 have been similarly limited. Support for this additional claim elements may be found in the first full paragraph of page 7 of the specification.

Claims 1-58 are now clearly differentiated over the prior art, in general, and over U.S. Pat. Appl. No. US 2002/0188532 to Rothstein, in specific. For example, Rothstein

is directed to commercial advertising and fails to provide any teaching or suggestion of the use of laudatory statements regarding not-for-profit organizations. Moreover, “Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter . . . the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable” In re Gulak (217 USPQ 403).

Moreover, the claimed laudatory statements are functionally related to the process and apparatus for creating “ad-books.” For example, it has been found that the liberal use of laudatory statements and/or images in “ads” of “ad-books” (limited only by the contributor’s imagination) encourages greater generosity in contributions from other contributors to the non-for-profit organization. As such, laudatory statements are functionally related to the process of publishing “ads” in “ad-books” by not-for-profit organizations.

Moreover, “the burden of establishing the absence of a novel, non-obvious functional relationship rests with the PTO” (In re Lowry, 32 USPQ2d 1035). Since the laudatory statements are functionally related to the publication of “ad-books”, the laudatory statements are entitled to be patentable weight.

Moreover, the Office Actions have failed to demonstrate the existence of any relevant art directed to the not-for-profit sector. In each case, the references cited in the Office Actions have been directed to commercial endeavors, not to not-for-profit organizations. Since the claims are directed to not-for-profit organizations, the claims are clearly differentiated over the cited art.


Closing Remarks

Allowance of claims 1-58, as now presented, is believed to be in order and such action is earnestly solicited. Should the Examiner be of the opinion that a telephone conference would expedite prosecution of the subject application, he is respectfully requested to telephone applicant's undersigned attorney.

The Commissioner is hereby authorized to charge any additional fee which may be required for this application under 37 C.F.R. §§ 1.16-1.18, including but not limited to the issue fee, or credit any overpayment, to Deposit Account No. 23-0920. Should no

proper amount be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 23-0920.

Respectfully submitted,
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